

Appl. No. 09/833,847  
Response Dated February 23, 2003  
Reply to Office Action of 11/21/03

### **Responses to Examiner's Remarks in Detailed Action**

Reconsideration of the application is respectfully requested. The Application stands rejected under 35 USC § 103(a) as to all claims currently pending, on the basis of JP '573 in combination with GB '758, as well as various prior art references. Common to all rejections is the reliance upon JP '573 in combination with GB '758. Based on the explanation below, Applicant respectfully requests that the Examiner withdraw the rejections.

#### **§ 112 Issues**

The Examiner objected to Claims 2, 13 and 16 for informalities, which are corrected as follows:

Claim 2 is amended to include a period at the end.

Claim 13 is amended to change the term "a payload" to "the payload".

Claim 16 is amended to change the term "it" to "the covering," and "a payload" to "the payload".

Claim 1 is corrected in response to the Examiner's Paragraph 2 by replacing the term "which rod" with "wherein the rod" to avoid indefiniteness issues.

Claim 15 is corrected in response to the Examiner's Paragraph 2 by replacing the term "which rod" with "wherein" and completion of the phrase with "over the rod" to avoid indefiniteness issues.

Claim 19 is revised by changing the term "which rod" to "that".

#### **Claim Rejections, § 103**

##### **Re: All Claims**

The reference JP '573 in combination with GB '758 serves as the basis for all rejections of claims 1 through 16. No rejection levied includes any alternative basis rendering reliance upon a combination of JP '573 with GB '758 unnecessary. Accordingly, by

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demonstrating JP '573 and GB '758 are not properly combinable, applicant overcomes each rejection.

For a combination to support an obviousness rejection, the combination must not destroy the function of the prior art reference. See, e.g., In re Gordon, 733 F.2d 900 (Fed. Cir. 1984) (turning prior art device upside down not permissible where it would prevent proper operation of that device).

Also, the combination must produce a workable result. See, e.g., In re Sponnoble, 405 F.2d 578, 587 (C.C.P.A. 1969) (forbidding combination that "would produce a seemingly inoperative device."); McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1354 (Fed. Cir. 2001) ("If references taken in combination would produce a 'seemingly inoperative device,' we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness").

GB '758 is not properly combinable with JP '573. Attempting such a combination impermissibly destroys the function of GB '758 and creates an unworkable device. In the present case, the examiner cites GB '758 for the presence of a free standing rod.<sup>1</sup> Applicant does not dispute that GB '758 includes a free standing rod, but the rod shown in GB '758 performs a different – and incompatible – function compared to the function of the present invention. Specifically, the rod 14 in GB '758 is a dispenser, not a drape mechanism. In GB '758, the tarp is wound with substantial pre-planning or effort about the rod 14 before a vehicle is moved into place. The rod of GB '758 is not meant to spin freely, or even to allow passage of any material over itself; rather, it is meant to unwind a spooled covering.

By contrast, the rod of the present invention is a free-spinning rod that does not dispense a covering. The covering is not attached to the rod of the present invention, but drapes over it, allowing free movement and positioning.

<sup>1</sup> ("With regard to claim 1, JP '573, as modified, lacks the rod being supported independently of the vehicle. . . . GB '758 teaches an apparatus including . . . a rod 14" (Office Action, p. 4).

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With reference to the legal standard for obviousness, attempting to use the GB '758 rod in the manner of the present invention would destroy the intended function of GB '758. By way of example, rolling a covering over the top of the dispenser rod 14 of GB '758 would likely cause the covering contained on that dispenser to tangle or roll back over itself. If the dispensed tarp unrolled at all from the GB '758 rod 14, it would fall in a useless mass behind the vehicle.

Moreover, the Applicant notes that the dispenser rod 14 of GB '758 and the instant invention's rod have clearly opposite functions. The present invention's rod is intended to support only a portion of the tarp at any given time, in the manner of draping. The GB '758 rod is attached to the entire covering, and leaves no free trailing end. In function, a distinction is also seen; specifically, (1) GB '758 requires greater preparation and effort than the present invention (the covering must be pre-loaded; whereas most truckers will have their own tarps for each vehicle, which are accustomed to being carried with the vehicle, rather than swapped among vehicles at each loading port); and (2) GB '758 relies upon the movement of the vehicle to unwind the covering; whereas the more free draping of the covering in the present invention allows custom fitting and manipulation of the covering over a stationary payload, to a greater degree than is allowed by the necessarily uniform unrolling of the pre-rolled covering over a moving vehicle.

The foregoing discussion applies to all claims, given that JP '573 and GB '758 are foundation combinations for all rejections of each claim. Additionally, Applicant notes with some dismay the number references sought to be combined in order to reject some of the later dependent claims. By way of example, Claims 13 to 14 are rejected by the examiner based on a combination of (1) JP '573, (2) Ray, (3) GB '758, (4) Casteel, and (5) "well known prior art," being therefore a rejection based on a combination of at least 5 different references. Applicant urges the examiner to reconsider the lengths taken to arrive at such a rejection in light of the requirement that hindsight not be used (McGinley, 262 F.3d at 1351) to pick and choose prior art combinations. In fact, the very necessity of employing so many different references to formulate a rejection actually suggests that

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the invention is not obvious as a whole. See, e.g., In the Matter of Spring Assemblies and Components Thereof, and Methods for their Manufacture, 1981 ITC LEXIS 178, \*45 (ITC 1981) ("The many references combined by respondents in their attempt to invalidate the '287 patent claims in issue are indications that the invention as a whole was not obvious.").

Applicant respectfully requests that the examiner withdraw the combination rejection involving GB '758, and all dependent rejections.

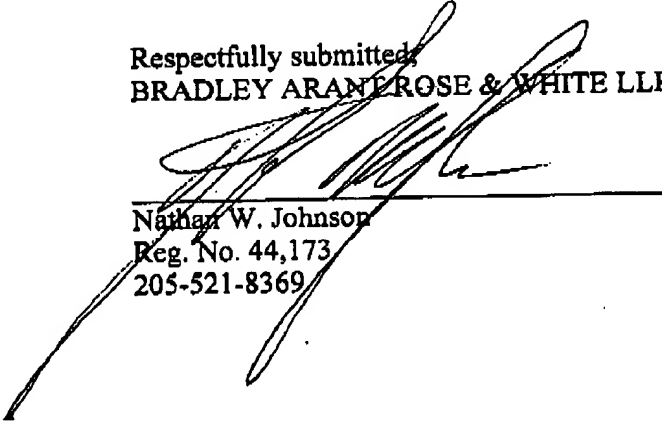
Fees

This response is timely and no fees or extensions are required.

Applicant has diligently sought to comply with all requirements and to correct all informalities and objections. The Application is believed to be in condition for allowance, and a timely Notice of Allowance is respectfully requested.

2-23-04  
Date

Respectfully submitted,  
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